

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,953	03/13/2001	Dan C. Morgan	MB4315.002	1190
22798	7590	08/25/2005	EXAMINER	
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C. P O BOX 458 ALAMEDA, CA 94501			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 08/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,953

Applicant(s)

MORGAN, DAN C.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3629

Applicant's amendment of 7/8/05 has been entered. Currently claims 1-18 are pending. The examiner will address applicant's arguments at the end of this office action.

1. Claim 1 and 4 are objected to because of the following informalities:

For claim 1, there does not appear to be any antecedent basis for the term "central computer" but the examiner is fairly certain this is the same as the central computer system (so the claim is not considered indefinite). Applicant has amended the recitation of "central computer" to now be "central computer system"; however, future recitations of this limitation were not amended accordingly. Applicant is requested to keep the terminology consistent in the claims and if you call it a central computer system it must be referred to as a system later on. Correction is required.

For claim 4, the portion of the claim that reads "and a serial a number" needs to be corrected to read "and a serial number". Appropriate correction is required.

2. The amendment filed 7/8/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

For claim 5, applicant has claimed "**further** wherein: said collector is provided with a certificate of authenticity bearing...". The specification as

Art Unit: 3629

originally filed does not provide support for there being two certificates of authenticity as claimed. The first certificate is the one recited in claim 1 that is signed by the collector and the second certificate is the one recited in claim 5 as being **further** provided to the collector. The scope of claim 5 has two certificates of authenticity, which is new matter because the specification as originally filed failed to disclose two.

For claim 10, the examiner has referred to the instant specification and cannot find any reference to "a set of user interfaces". The specification as originally filed fails to provide support for this limitation and it is not clear what the user interfaces actually are. The limitation of there being a set of user interfaces is considered to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5,6,10-18, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3629

For claim 5, applicant has claimed "further wherein: said collector is provided with a certificate of authenticity bearing...". The specification as originally filed does not provide support for there being two certificates of authenticity as claimed. The first certificate is the one recited in claim 1, that is signed by the collector, and the second certificate is the one recited in claim 5 as being further provided to the collector. The scope of claim 5 has two certificates of authenticity, which is new matter because the specification as originally filed failed to disclose two.

For claim 10, the examiner has referred to the instant specification and cannot find any reference to "a set of user interfaces". The specification as originally filed fails to provide support for this limitation and it is not clear what the user interfaces actually are. The limitation of there being a set of user interfaces is considered to be new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6,9,10-18, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 6, there is no antecedent basis for "said serial number". No serial number has previously been claimed in claim 5 or claim 1, so it is not clear as to what this refers to. The examiner has interpreted the claim to be newly

Art Unit: 3629

reciting that a serial number is assigned to the collectible; however, correction is still required.

For claim 9, applicant has more than one recitation that is directed to a range in a range, which is indefinite. The limitation of "any limited edition information available" is a broad range of information, where the limitations of "such as the sequence...and the total number in the limited edition" are the narrow range of information. It is not clear whether or not the claim will be satisfied by any limited edition information or if the claim requires the limited edition information to be "the sequence" and the "total number in the limited edition".

For claim 10, the examiner takes notice that the claim scope does not appear to require the collector to actually send any information in response to the request for information. It is not clear to the examiner what the scope of this claim is. If no information is being provided or actually sent by the collector, then there is no certificate of authenticity to be created, so does the absence of a sending information step by the collector mean that the claim scope is broad enough to simply include providing user interfaces and requesting two types of information with nothing further happening? If no information is received then no certificate of authenticity would be generated. The examiner feels that this claim is lacking in an essential step, which is the sending of information by the collector; otherwise, no certificate is being generated. Because of the manner in which the claim is drafted, the scope cannot be ascertained and the claim is considered indefinite. Additionally, with respect to claim 10, what is meant by "a

Art Unit: 3629

set of user interfaces"? The specification does not discuss any interfaces at all and the examiner has no idea what is meant by "a set of user interfaces". What are they? An interface is a broad term and because it is not found in the specification as originally filed, the examiner does not know what the scope of this term is. Claim 10 is indefinite.

For claim 16, what is meant by "similar to the way"? One wishing to avoid infringement would not know what is considered to be "similar" and what is not. It is not clear as to what the method of reregistering is made up of because it is not known what "similar" means. The scope of this claim is unclear.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10,15-18, are rejected under 35 U.S.C. 102(b) as being anticipated by DiCesare et al. (5971435).

For claims 10,15,18, DiCesare inherently discloses that an originating computer is used to send information (collector and collectible information) to a central computer. For the information about the signing to be transmitted electronically to the computer database (central computer), an originating computer of some kind is inherently required to send the information. The information is stored as claimed at the central computer. A computer inherently

Art Unit: 3629

has a set of user interfaces as claimed, which can be interpreted to be a keyboard and/or a mouse and/or a display of a computer, all of which are user interfaces. DiCesare discloses that information is to be sent to a central computer so that the information can be stored for future use. The collector is requested the claimed information in DiCesare, in person and by the central computer. The claimed generation of a certificate of authenticity is considered to be the providing of the voucher of DiCesare to the collector. The voucher is a certificate of authenticity and is generated based on the information provided by the collector at the signing event. The voucher contains the signature of the collector as claimed and has a guarantee in writing as claimed. See figure 2.

For claims 16,17, a new owner is allowed to register the collectible in a manner that is similar to the method that the previous owner went through. Once a new owner registers the change of ownership with the central computer, the new information is added as claimed.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9,10-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over DiCesare et al. (5971435).

Art Unit: 3629

For claims 1,9,12, DiCesare discloses a method and system for verifying the authenticity of an autograph on a collectible item. It is disclosed that the collector personally witnesses the signing of the item as claimed. The step of connecting an originating computer to a central computer via an online communication system is disclosed in column 4, lines 35-38. For the information about the signing to be transmitted electronically to the computer database (central computer), an originating computer of some kind is inherently required to send the information. The information about the collector and collectible are provide solely by the collector as claimed because the collector is the one who would provide their name and address and also are the one who decides what the collectible item is that is to be signed. Because the collector is the one who brings and decides what the autographed item is to be signed, they are providing the information about the collectible as claimed. DiCesare discloses the storing of information as claimed on the central computer. DiCesare discloses the providing of information to the central computer and storing of information as claimed. DiCesare discloses a certificate of authenticity, which the examiner considers to be the voucher 3. The voucher 3 is a certificate of authenticity.

DiCesare does not disclose that the witness signs a statement that declares under penalty of perjury that the information about the collectible item is correct.

With respect to having the witness sign a statement under the penalty of perjury, the examiner notes that DiCesare already requires the witness to sign the voucher, but nothing is disclosed about the penalty of perjury limitation. It

Art Unit: 3629

would have been obvious to one of ordinary skill in the art at the time the invention was made to have the witness sign the voucher just like an affidavit, under the penalty of perjury. It is old and well known in the art that when a person needs to make a sworn statement or attest to particular facts in a more official and legally binding manner, one can sign an affidavit or declaration under the penalty of perjury. This way the signing of the witness on the voucher has on a more trustworthy and convincing affect. Having the witness sign a statement under the penalty of perjury is nothing new and is considered obvious to one of ordinary skill in the art.

For claim 2, DiCesare discloses that users are allowed access to information on a collectible as claimed.

For claims 3,7, DiCesare allows what is claimed (transfer of ownership as claimed). The new information about the new owner can be stored by the central computer as claimed.

For claims 4,6,14, DiCesare discloses that a unique code number 16 is provided for the collectible at the central computer. This happens after the information has been sent to the central computer and satisfies what is claimed. With respect to the providing of a user number, this is not expressly disclosed by DiCesare. The examiner interprets the "user number" to be the same as an account identifier for the collector, such as an account number. The use of account numbers for purposes of identifying a particular person's account is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to give the collector an account

Art Unit: 3629

number as claimed so that there is an easy way to access and identify the collector's account.

For claims 5, 11, DiCesare does not disclose that the certificate of authenticity (the voucher) has a hologram with a bar code as claimed, where the collectible item also has the same hologram. DiCesare already recognizes that the voucher and signed item are to have an identifier that is the same so as to link the two together. DiCesare discloses that in 1997 Sports Collectors Digest authenticated signed items by using holograms. See column 1, lines 66-column 2, line 5. Also see column 3, lines 34-40 where it is disclosed that the certificate of authenticity may have a hologram. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the identifier of DiCesare that is on the voucher and on the signed item to be a hologram as is known in the art for as a good form of authentication. With respect to the bar code, it would have been obvious to have a bar code on the voucher and signed item for an additional way to authenticate the signed item. This limitation is interpreted to simply be a 2nd identifier on the item and voucher and is considered obvious.

For claim 8, if and when an owner of a collectible transfers ownership of the collectible to a new owner, it is disclosed that the backside of the certificate of ownership is filled out and given to the new owner. This can be seen in figure 3b. The new owner takes possession of the certificate of ownership from the prior owner and this satisfies what is claimed. When the original owner transfers ownership to a subsequent owner, the subsequent owner will have the original

Art Unit: 3629

certificate of authenticity that shows the history of the collectible (figure 3a) as well as the chain of ownership (as shown in figure 3b).

For claims 10,13, DiCesare discloses a method of authenticating a signed collectible as claimed. The collector provides information about themselves and a collectible item as claimed. The information is sent to a central computer by an originating computer (that is inherent) and based on the provided information a certificate of authenticity (figs 3a and 3b) is generated. The computer inherently has a user interface such as a keyboard and/or a mouse and/or a display of a computer, all of which are user interfaces. The certificate of authenticity is provided only after the collector provides the required information and completes the data transmission by computer. Completion of a "customer inquiry screen" is inherent in DiCesare because you cannot send data to the central computer without having to fill out something to cause the data to be sent. The term "customer inquiry screen" is very broad and does not mean any specific kind of screen. Not disclosed is that questions are asked of the collector as claimed and that the certificate of authenticity contains a guarantee in writing and the signature of the collector as claimed. With respect to the asking of a series of questions , it would have been obvious to one of ordinary skill in the art at the time the invention was made to ask the collector questions such as what kind of article did you bring to be signed and who is going to be signing it today. DiCesare discloses that the collector is to provide information about themselves and the collectible so the most obvious way to ensure the proper collection of the required information would be to ask questions as claimed. With respect to

Art Unit: 3629

having the certificate of authenticity contain a guarantee and a signature of the collector the examiner notes that the voucher of DiCesare contains a guarantee and a signature of the collector that attests to the fact that the information is correct. DiCesare already recognizes the usefulness of having a guarantee in writing and the signature of the collector, just not on the certificate of authenticity as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the certificate of authenticity (fig 3a) with a written guarantee and a signature of the collector, just as the voucher does, to add to the level of confidence one would have in the authentication of the article.

11. Applicant's arguments filed 7/8/05 have been fully considered but they are not persuasive. Applicant has argued that the prior art does not disclose a situation where company representative is not needed and that the collector can generate the signature without the representative. In response the examiner notes that the claims do not exclude a company representative from being present as has been argued. The argument is not commensurate with the scope of the claims. This is the only argument presented as far as the examiner can tell and because it is not persuasive, the rejection will be maintained.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3629

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER